REMARKS

No claims have been canceled, amended or added in this paper. Therefore, claims 11-28 and 34-54 are pending and are under active consideration.

Claims 11, 16-18, 20-28, 34-35, 37-40, 44-45, 47-49 and 53 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Grabau et al. (US Patent No. 6,451,154) in view of Nowaczyk (US Patent No. 6,096,153)." In support of the rejection, the Patent Office states, with respect to the rejected independent claims, the following:

> As to claim 11, Grabau teaches a tag comprising:
> an inlay 15 (fig. 3) comprising:
> i. a carrier sheet 12,
> ii. an antenna 15B, and
> iii. a wireless communication device 15A.
>
> Grabau fails to disclose top and bottom plastic extrudates with a cavity to receive the inlay 15. However, Nowaczyk teaches a tag including:
> a. a top plastic extrudate member 46 and
> b. a bottom plastic extrudate member 32 (see fig. 2), the bottom plastic extrudate member being shaped to include a cavity 28 adapted to receive a resonant circuit 30 of a tag, wherein the top and the bottom plastic extrudate member cooperatively encapsulate the tag circuit.
>
> In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14.
>
> Though the figure dictates that cavity 28 is [formed] in the top extrudate, it should be noted that the Nowaczyk casing when flipped around would become the bottom extrudate. The terms "top" and "bottom" are only relative and would be interpreted accordingly.
>
> ...
>
> As to claim 16, Grabau teaches a tag comprising:
> a. an inlay comprising:

i. a carrier sheet 12,
ii. an antenna 15B, and
iii. a wireless communication device 15A.

Grabau fails to disclose a casing for the inlet 12. However, Nowaczyk teaches a tag including:

b. a plastic casing comprising:

i. a bottom member 28 shaped to define a longitudinal cavity (fig 2 or 3)

ii. a top member 32 applied to the bottom member 46 to at least partially enclose the longitudinal cavity for a tag circuit.

In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14.

Though the figure dictates that cavity 28 is [formed] in the top extrudate, it should be noted that the Nowaczyk casing when flipped around would become the bottom extrudate. The terms "top" and "bottom" are only relative and would be interpreted relatively.

...

As to claim 26, Grabau teaches a tag comprising:

a. an inlay comprising:

i. a carrier sheet 12,
ii. an antenna 15B, and
iii. a wireless communication device 15A coupled to antenna 15B. See fig. 3.

Grabau fails to disclose a casing for the inlet 12. However, Nowaczyk teaches a tag including:

b. a plastic casing comprising:

i. a bottom member 28 shaped to define a longitudinal cavity (fig 2 or 3)

ii. a top member 42 applied to the bottom member 46 to at least partially enclose the longitudinal cavity for a tag circuit, wherein the top member is a plug molded to the bottom member, that is, the top member is a cover to enclose the housing.

In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14.

Though the figure dictates that cavity 28 is [formed] in the top extrudate, it should be noted that the Nowaczyk casing when flipped around would become the bottom extrudate. The terms "top" and "bottom" are only relative and would be interpreted relatively.

...

As to claim 34, Grabau discloses a method of continuously manufacturing a plurality of tags, comprising the steps of:

a. providing a single continuous strip

b. depositing a continuous supply of inlays into the continuous strip,

c. the continuous supply of inlays comprising a carrier web, a plurality of antennae 15B disposed on the carrier web at spaced intervals (fig. 7), and a wireless communication device 15A coupled to each of the antennae (fig. 3),

[d]. applying a cover 14 over the continuous supply of inlays (fig. 3)

[e]. cutting the continuous supply of inlays and the single continuous strip between successive antennae to yield individual tags (this is inherent because each of RFID devices is for use on separate item or individual).

Though the cover 14 appears to be individually deposited on each inlay, it would have been obvious to one of ordinary skill in the art to use a continuous sheet because they are functionally equivalent as to provide a cover for the inlays.

Grabau fails to disclose a casing for the inlet 12. However, Nowaczyk teaches a tag including a plastic casing comprising a longitudinal cavity (fig. 2 or 3). In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14. It would follow then that the cover 14 of Grabau would be replaced by cover 42 in the casing of Nowaczyk's.

...

As to claim 44, Grabau discloses a method of continuously manufacturing a plurality of tags, comprising the steps of:

a. providing a single continuous strip

b. depositing a continuous supply of inlays into the continuous strip, each inlay comprising a carrier sheet 12, an antenna 15B disposed on the carrier sheet, and a wireless communication 15A,

c. the continuous supply of inlays comprising a carrier web, a plurality of antennae 15B disposed on the carrier web at spaced intervals (fig. 7), and a wireless communication device 15A coupled to each of the antennae (fig. 3),

[d]. applying a cover 14 over the continuous supply of inlays (fig. 3)

[e]. cutting the continuous supply of inlays and the single continuous strip between successive antennae to yield individual tags (this is inherent because each of RFID devices is for use on separate item or individual).

Though the cover 14 appears to be individually deposited on each inlay, it would have been obvious to one of ordinary skill in the art to use a continuous sheet because they are functionally equivalent as to provide a cover for the inlays.

Grabau fails to disclose a casing for the inlet 12. However, Nowaczyk teaches a tag including a plastic casing comprising a longitudinal cavity (fig. 2 or 3). In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14. It would follow then that the cover 14 of Grabau would be replaced by cover 42 in the casing of Nowaczyk's.

...

As to claim 49, Grabau discloses a method of continuously manufacturing a plurality of tags, comprising the steps of:

a. providing a single continuous member 32,

b. depositing a continuous supply of inlays into the continuous member, each inlay comprising a carrier sheet 12, an antenna 15B disposed on the carrier sheet, and a wireless communication 15A;

c. the continuous supply of inlays comprising a carrier web, a plurality of antennae 15B disposed on the carrier web at spaced

> intervals (fig. 7), and a wireless communication device 15A coupled to each of the antennae (fig. 3),
>
> [d]. applying a plug 14 over the continuous supply of inlays (fig. 3)
>
> [e]. cutting the continuous supply of inlays and the single continuous strip between successive cavities to yield individual tags (this is inherent because each of RFID devices is for use on separate item or individual).
>
> Though the cover 14 appears to be individually deposited on each inlay, it would have been obvious to one of ordinary skill in the art to use a continuous sheet because they are functionally equivalent as to provide a cover for the inlays.
>
> Grabau fails to disclose a casing for the inlet 12. However, Nowaczyk teaches a tag including a plastic casing comprising a longitudinal cavity (fig. 2 or 3). In light of Nowaczyk's teaching, it would have been obvious to one skilled in the art [to] provide a housing cavity as that disclosed in Nowaczyk to house inlay 15 of Grabau because such housing would provide protection for inlay 15 than the face cover 14. It would follow then that the cover 14 of Grabau would be replaced by cover 42 in the casing of Nowaczyk's.
>
> ...

Applicants respectfully traverse the subject rejection. As best understood by Applicants, the Patent Office appears to be taking the position (i) that the combination of Grabau paper 12, Grabau chip 15A, and Grabau antenna 15B corresponds to the claimed inlay; (ii) that the combination of Nowaczyk housing 26 and Nowaczyk lid 38 corresponds to the claimed casing; and (iii) that it would have been obvious to one of ordinary skill in the art at the time of the invention to house the combination of Grabau paper 12, Grabau chip 15A and Grabau antenna 15B in the casing formed by Nowaczyk housing 26 and Nowaczyk lid 38. Applicants respectfully disagree for at least the reasons below.

As a preliminary matter, Applicants wish to review the teachings of Grabau et al. and Nowaczyk and to point out some of the distinctions between the Grabau method of manufacturing RFID labels and the Nowaczyk method and system for manufacturing security tags.

Grabau et al. is directed at a method of making radio frequency identification (RFID) labels. According to one embodiment, the method of Grabau et al. involves providing a paper web 12 having a plurality of conventional RFID inlets 15 mounted thereon at regularly spaced intervals. Each of the RFID inlets 15 includes a chip 15A and an antenna 15B. The paper web 12 is moved past a station 16 where a conventional RFID reader/writer is used to check the functionality of the RFID inlet 15 and/or to program the RFID inlet 15. The paper web 12 is eventually moved to a lamination stage 20, where a pair of lamination rollers 21 and 22 are used to laminate paper web 12 to an adhesively-coated second web 32 (or 38), thereby yielding a composite web 40 in which inlets 15 are sandwiched between paper web 12 and second web 32 (or 38) and in which the adhesive-coating of second web 32 faces towards paper web 12. The composite web 40 is then die-cut to create a plurality of labels 48. After die-cutting, the web 40 is passed through a final RFID read verification stage 42. Web 40 is then passed through rolls 43, at which variable indicia, using ink jet technology or the like, are printed onto the RFID labels. The matrix material from the die-cutting step is then removed from web 40, thereby leaving a final web 44 consisting of a plurality of discrete labels 48 spaced apart on second web 32 (or 38). Each label 48 has indicia 50 (which may be variable indicia or both variable and non-variable indicia) imprinted on its top surface 14. The back surface of each label 48 has pressure sensitive adhesive 49. Each inlet 15 is sandwiched between the paper forming web 12 and the adhesive 49.

Nowaczyk is directed at a method and system for continuously manufacturing security tags. According to one embodiment, the method and system of Nowaczyk involves providing a first continuous web of plastic material. A plastic former is then used to form housing cavities in the plastic material without separating the continuous web. A resonator feeder is downstream of the plastic former and is used to place a resonator strip in each of the housing cavities. A lid stock supply is downstream of the resonator feeder and places lid stock material over open ends of the housing cavities to seal the housing cavities with the resonator strips therein. A bias feeder is downstream of the resonator feeder and is used to attach bias strips to the outer surface of the lid stock material remote from the housing cavities. A cover supply is adjacent the bias feeder and is used to place cover stock material over the bias strips and outer surface of the lid stock material.

In view of the above, it can clearly be seen that there are several important distinctions between Grabau et al. and Nowaczyk. First, Grabau et al. is directed at **a label for displaying indicia**. By contrast, Nowaczyk is not directed at a **label**, but rather, is directed at an electronic security tag. There would have been no reason for a person of ordinary skill in the art to put the Grabau label in the Nowaczyk housing **since putting the Grabau label in the closed and sealed Nowaczyk housing would prevent the indicia on the Grabau label from being observed, thus rendering the Grabau label useless for its intended purpose.**

Another important distinction between Grabau et al. and Nowaczyk is that Grabau et al. involves the use of RFID technology whereas Nowaczyk does not involve the use of RFID technology, but rather, involves technology comprising the combination of a resonator and a magnetizable bias strip. As explained in Nowaczyk (see col. 1, lines 30-45), in a resonator-containing device, a resonator strip is loosely mounted in a container to permit its vibration within

the container. A magnetic bias strip is attached to the outside of the container and is covered with a plastic layer. When the bias strip is magnetized, the resonator vibrates in response to a signal from a transmitter. As can clearly be appreciated, the RFID label of Grabau et al. does not include a resonator strip and is not intended to vibrate in the same fashion as a resonator strip. In fact, to the contrary, the Grabau et al. label includes an adhesive on its bottom surface that would keep the label from moving within the Nowaczyk housing. A person of ordinary skill in the art would have recognized that the Grabau label operates by an entirely different mechanism than the Nowaczyk security tag and would not have been motivated to use the Grabau label in the Nowaczyk housing.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 12, 14 and 15 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Grabau et al. (US Patent No. 6,451,154)." In support of the rejection, the Patent Office states the following:

> As to claim 12, Grabau discloses a method of continuously manufacturing a plurality of tags, the method comprising the steps of:
>
> providing a continuous supply of inlays (figs 1 and 4), continuous supply of inlays comprising a continuous carrier web (col. 5, lines 39-48), a plurality of antennae 15B positioned on the continuous carrier web at spaced intervals and a wireless communication device coupled to each of the antennae,
>
> feeding said continuous supply of inlays into an extruder (fig. 1) so as to yield a continuous block which includes the continuous supply of inlays surrounded by a plastic extrudate, and
>
> cutting the continuous block between successive antennae so as to yield individual tags, this step is inherent because each tag is to use separately on a different item or individual.
>
> Though Grabau fails to disclose a cross-head extruder, it would have been obvious to one skilled in the art to use a cross-head extruder in the Grabau extruding system because it is conventional in the art for applying layers of material on a web.

> As to claim 14, one of ordinary skill would have readily recognized that cooling step must [be] done only after the feeding step because the inlets must be formed before any other steps to be taken, and to wait for the continuous block to cool before cutting the continuous block into individual tag.
>
> As to claim 15, Grabau discloses the step of coupling a mounting adhesive 49 to the underside of the continuous block. See fig. 3.

Applicants respectfully traverse the subject rejection. As best understood by Applicants, the Patent Office appear to be taking the position (i) that Grabau et al. teaches the claimed continuous supply of inlays; (ii) that Grabau et al. fails to disclose a cross-head extruder; but (iii) that it would have been obvious to use a cross-head extruder because cross-head extruders are "conventional in the art for applying layers of material on a web." Applicants respectfully traverse the subject rejection for at least the reasons below.

As noted above, Grabau et al. is directed at a method of manufacturing RFID labels. Each of the Grabau labels is releasably mounted on a common web and comprises a front surface, on which variable (or both variable and invariable) indicia are displayed, and a back surface, on which an adhesive is applied. The Patent Office is apparently arguing that it would have been obvious to feed the continuous supply of Grabau inlays into a cross-head extruder so that additional layers of material could be applied to the labels; however, Applicants respectfully submit that the Patent Office has failed to explain **why one would want to apply any additional layers to the Grabau label**. As can readily be appreciated, if additional layers were applied to the top surface of the Grabau label, the indicia on the top surface of the label would be obscured, thus rendering the label useless for its intended purpose.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 13, 19, 36, 41-43, 46 and 50-52 stand objected to "as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims."

Applicants respectfully traverse the subject objection. The subject objection is predicated on the objected claims being dependent from a rejected base claim. However, as explained above, the rejection of the base claim is in error. Therefore, the subject objection is in error and should be withdrawn.

In conclusion, it is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Kriegsman & Kriegsman

By: _____

Edward M. Kriegsman
Reg. No. 33,529
30 Turnpike Road, Suite 9
Southborough, MA 01772
(508) 481-3500

Dated: December 30, 2008

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 30, 2008.

_____

Edward M. Kriegsman
Reg. No. 33,529
Dated: December 30, 2008